OFFICE OF THE CLERK
RECEIVED
MAY 10 1915
SUPREME COURT U. S.

No. 194.

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A. D. 1914.

THE UNITED STATES, ex rel EDWARD L. CHOTT,
Plaintiff in Error,
vs.
THOMAS EWING, Commissioner of Patents, and HERBERT WRIGHT, Primary Examiner, United States Patent Office,
Defendants in Error.

PETITION FOR REHEARING.

JOSHUA R. H. POTTS,
ATTORNEY FOR PLAINTIFF IN ERROR.

BARNARD & MILLER PRINT, CHICAGO.

IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1914.

No. 194.

THE UNITED STATES, ex rel EDWARD L. CHOTT,
Plaintiff in Error,
vs.
THOMAS EWING, Commissioner of Patents, and HERBERT WRIGHT, Primary Examiner, United States Patent Office,
Defendants in Error.

PETITION FOR REHEARING.

Now comes United States *ex rel.* Edward L. Chott, plaintiff in error herein, by Joshua R. H. Potts, its attorney, and petitions this Honorable Court to set aside its judgment and decision entered in the above entitled cause on April 12, 1915, and grant a rehearing herein for the reasons hereinafter specified and set forth.

The court holds that the proceeding herein for extraordinary relief by way of mandamus is a case "arising under the patent laws" and that therefore this court has no jurisdiction.

The patent laws are purely statutory laws, there being no exclusive rights in or to inventions except as

are conferred by the statutes. Nowhere in the statutes relating to patents does the word *mandamus* appear and the query arises as to how it is possible that a proceeding for mandamus could arise under statutes in which mandamus is not even mentioned.

In this connection it is contended that the right to relief by way of mandamus to enforce finally adjudicated rights, is a right arising purely and simply under the common law and has nothing whatever to do with the subject-matter of the adjudication. In this connection it is desired to direct attention to the decision of Chief Justice TANEY in *Commonwealth of Kentucky* v. *Dennison, Governor, etc.,* 65 U. S. 66-97, in which it is stated as follows:

> "It is equally well settled, that a mandamus in modern practice is nothing more than an action at law between the parties, and is not now regarded as a prerogative writ."

See, also, the decision of this court in *Ward* v. *Gregory,* 7 Peters 633, in which it was held as follows:

> "A proceeding at mandamus being at common law, the removal to this court should be by writ of error not by appeal."

See, also, the decision of the Circuit Court of Appeals for the Sixth Circuit, in *Muhlenberg County* v. *Dyer et al.,* 65 Fed. Rep. 634, opinion by Mr. Justice TAFT, in which the syllabus is as follows:

> "An application for a writ of mandamus, being a proceeding at common law, can be reviewed in the Circuit Court of Appeals only by a writ of error, not by appeal." (See also, long list of authorities cited on page 635.)

See, also, Foster Federal Practice, Vol. 2, page 1185, which reads as follows:

> "The Supreme Court of the District of Columbia has the power to issue the writ of mandamus, in cases in which the relator is by common law entitled to seek relief, to an officer of the United States or other person within its territorial jurisdiction."

See, also, Dictionary of Terms and Phrases used in American & English Jurisprudence by Benjamin Vaughan Abbott, 1879, Vol. 2, page 76.

> "Mandamus—The name of a writ employed by courts of high jurisdiction, under common law systems, for compelling subordinate courts or officers to perform their duties."

See also Am. & Eng. Ency. of Law, 2d Edition, Vol. 19, p. 721, as follows:

> "Mandamus is a common-law remedy to compel action * * *."

See also The Law of Mandamus by Moses, published by William Gould & Son, 1867, page 17, as follows:

> "But in America the authority to issue a writ of mandamus, does not exist as a prerogative power of the courts; it is derived by grant from the government, through the constitution, or legislative enactments. And when the power has been granted in general terms to a court, *it is to be governed by the common-law rules, as to when it is proper to be issued.*" (Italics mine.)

See also Definitions of Words and Phrases published by West Publishing Co., 1904, Vol. 5, page 4329, as follows:

> "In mandamus proceedings, it is found on examination of the authorities *and it seems to be well settled, that such an action was a common-*

law action; * * * It is not now considered in most of the States of the Union as anything more than a civil action and in the procedure governing the trial of causes such procedure is assimilated as nearly as possible to the codes of the several States, *and is treated as an ordinary civil action in most of the States."* (Italics mine.)

See also Anderson Dictionary of Law, p. 651:

> "It may be said to be an established remedy to oblige inferior courts and magistrates to do that justice which they are in duty, and by virtue of their office, bound to do."

See also the comparatively recent decision of this court in *Ballinger* v. *Frost,* 216 U. S. 240-249-50, as follows:

> "That the performance of a ministerial duty can be compelled by mandamus have often been adjudged. As said by Mr. Justice Peckham, in *Roberts* v. *United States,* 176 U. S. 221, 229: 'The law relating to mandamus against a public officer is well settled in the abstract, the only doubt which arises being whether the facts regarding any particular case *bring it within the law which permits the writ to issue* where a mere ministerial duty is imposed upon an executive officer which duty he is bound to perform without any further question. If he refuse under such circumstances, mandamus will lie to compel him to perform his duty." (Italics mine.)

See also the decision of this court in *Sibbald* v. *United States,* 12 Peters 488; 37 U. S. 488-492, in which it is stated as follows:

> "When the Supreme Court had executed their power, in the cause before them, and their final decree or judgment requires some further act to be done, it cannot issue an execution, but shall send a special mandate to the court below to

award it. 24th Sect. J. A. (1 U. S. Stat. 85.) Whatever was before the court, and is disposed of, is considered as finally settled. The inferior court is bound by the decree as the law of the case; and must carry it into execution, according to the mandate. They cannot vary it, or examine it for any other purpose than execution; or give any other or further relief; nor review it upon any matter decided upon appeal for error apparent; nor intermeddle with it, further than to settle so much as has been remanded. * * * If the special mandate directed by the 24th section is not obeyed or executed, then the general power given to 'all the courts of the United States to issue any writs where necessary for the exercise of their respective jurisdictions' agreeable to the principles and usages of law, by the 14th section of the judiciary act, fairly arises and a *mandamus* or other appropriation writ will go."

The last case cited was a controversy arising over land which had been finally adjudicated as in the case at bar, but the court held that the right to the writ of mandamus arose, *not under the land laws, but under other laws,* and it is urged that this case is decidedly in point as showing that the right to relief by mandamus arises under general principles of law, and not under the principles of law involved in the original litigation which has been finally adjudicated, and which it is sought to enforce by mandamus. In the case at bar, it is contended, that the case which arose under the patent laws was the appeal to the Board of Examiners in Chief and when that was finally adjudicated in favor of plaintiff in error, that case was terminated and settled, and the right to enforcement of that final adjudication by mandamus arose, not under the patent laws, but under the com-

mon or general law which gives every litigant the right to have finally adjudicated rights enforced by mandamus, *and that the subject-matter of the original litigation which has been finally adjudicated is entirely immaterial, the right to mandamus arising whether the title to a cow, or a tract of land, or a recovery in an action for tort, or a right to a pension, or a right to a patent* was involved in the original litigation.

See, also, Words and Phrases, Vol. 3, page 254, as follows:

> "The right to sue out the writ is not made to depend on the character of the dispute but on what answer is given to the question, Can the ordinary courts of law afford a plain, speedy, and adequate remedy?"

See, also, the decision of this court in *Kendall* v. *United States,* 37 U. S. 522, at page 620, which reads as follows:

> "The theory of the British government, and of the common law, is, that the writ of mandamus is a prerogative writ, and is sometimes called one of the flowers of the crown, and is, therefore, confided only to the king's bench; where the king, at one period of the judicial history of that country, is said to have sat in person, and is presumed still to sit. And the power to issue this writ is given to the king's bench only, as having the general surviving power over all inferior jurisdictions and officers, and is co-extensive with judicial sovereignty. *And the same theory prevails in our state governments, where the common law is adopted,* and governs in the administration of justice; and the power of issuing this writ is generally confided to the highest court of original jurisdiction. But it cannot be denied, but this common-law principle may be modified by the legislature, in any manner

that may be deemed proper and expedient. No doubt, the British parliament might authorize the court of common pleas to issue this writ; or that the legislature of the states, where this doctrine prevails, might give the power to issue the writ to any judicial tribunal in the state, according to its pleasure; and in some of the states, this power is vested in other judicial tribunals than the highest court of original jurisdiction. This is done in the State of Maryland, subsequent, however, to the 27th of February, 1801. There can be no doubt, but that, in the State of Maryland, a writ of mandamus might be issued to an executive officer, commanding him to perform a ministerial act required of him by law; and if it would lie in that state, there can be no good reason, why it should not lie in this district, in analogous cases. *But the writ of mandamus, as it is used in the courts of the United States, other than the circuit court of this district, cannot, in any just sense, be said to be a prerogative writ, according to the principles of the common law.*" (Italics mine.)

See also the opinion of Chief Justice MARSHALL in *Marbury* v. *Madison*, 5 U. S. 137-170-178, as follows:

"But, if this be not such a question, if, so far from being an intrusion into the secrets of the cabinet, it respects a paper, which, according to law, is upon record, and to a copy of which the law gives a right, on the payment of ten cents; if it be no intermeddling with a subject over which the executive can be considered as having exercised any control, *what is there in the exalted station of the officer, which shall bar a citizen from asserting in a court of justice his legal rights,* or shall forbid a court to listen to the claim or to issue a *mandamus* directing the performance of a duty not depending on executive discretion, but on particular acts of Congress and the general principles of law? * * *

The judicial power of the United States is ex-

> tended to all cases arising under the constitution. Could it be the intention of those who gave this power to say, that in using it, the constitution should not be looked into? That a case arising under the constitution *should be decided without examining the instrument under which it arises?* This is too extravagant to be maintained." (Italics mine.)

In the case last cited, the court held that the circumstances presented called for the issue of mandamus but that the Supreme Court did not have original jurisdiction in this regard. This case is cited and relied upon as establishing the principle that the right to mandamus arises under general principles of law or special acts and not under the law of a finally adjudicated case which it is employed to enforce. Attention is also directed to the fact that Chief Justice Marshall thought it impossible to determine a case *arising under the constitution without consulting that constitution.* In the case at bar the patent statutes do not even mention the word *mandamus* so that it is thought that it is clearly impossible to determine when *mandamus* should or should not issue by consultation of the patent statutes. This being so, it would appear to be impossible that a right to *mandamus* could arise under the patent laws.

It is also desired to direct attention to the decision of Chief Justice Taney in *Sizer* v. *Many,* 57 U. S. 97, in which it was held that *in a case arising under the patent laws,* a writ of error which involved only the question of taxation of costs in such a case, was not a case arising under the patent laws. In this connection see the language employed on page 103, as follows:

"The discretionary power in this respect vested in the Circuit Courts by the Act of July 4, 1836, Sec. 17, is evidently confined to cases which involve the construction of the patent laws, and the claims and rights of patentees under them. *But the amount of costs which either party shall be entitled to recover is not regulated by these laws.* The costs claimed are allowed or refused in controversies arising under the patent acts, upon the same principles and by the same laws, which govern the court in the taxation of costs in any other case that may come before it. The same laws, therefore, must be applied to them in relation to the writ of error, and must limit the jurisdiction of this court as in other cases." (Italics mine.)

In the case at bar, the patent laws were involved only to the point at which the Board of Examiners in Chief finally adjudicated the original application in favor of plaintiff in error. At this point general principles of law intervened and when the Commissioner of Patents attempted to illegally withhold this patent, he was amenable to the common-law and general principles of law under the doctrines enunciated in the case last above cited. Surely if the costs involved in a case arising under the patent laws do not involve the patent laws, the application for a writ of mandamus to enforce rights finally adjudicated in a case arising under the patent laws also does not arise under the patent laws. In the case last above cited, the parties were exactly the same as in the patent case and the costs accruing arose in the patent litigation, whereas in the case at bar the application for patent was an *ex parte* proceeding and the application for writ of *mandamus* was made before an entirely different tribunal having absolutely no connection with the patent office and without jurisdiction

to review any rulings made in the patent office and involves entirely different parties. *From these considerations it appears clear that if the Supreme Court of the District of Columbia had jurisdiction to issue the writs of mandamus issued in the present case, it necessarily follows, that the proceeding involved in the present case is an entirely different and separate proceeding from that which arose in the patent office, inasmuch as the Supreme Court of the District of Columbia, now, has absolutely no jurisdiction whatever over matters arising in the patent office.*

In this connection it is also desired to direct attention to the comparatively recent decision of this court in *United States* v. *American Bell Telephone Co.*, 159 U. S. 548, which was a proceeding brought on the ground of fraud to cancel a patent. In this connection the court said on pages 553-4, as follows:

> "Nor is it necessary to pass upon that question in this instance, for the motion may be disposed of upon the inquiry whether it was manifestly the intention of Congress to include such a case as that before us in the words 'arising under the patent laws.' Now, actions at law for infringement, and suits in equity for infringement, for interference and to obtain patents, are suits which clearly arise under the patent laws, being brought for the purpose of vindicating rights created by those laws, and coming strictly within the avowed purpose of the act, to relieve this court of that burden of litigation which operated to impede the disposition of cases of peculiar gravity and general importance. We are of opinion that it is reasonable to assume that the attention of Congress was directed to this class of cases, and that the language was used as applicable only to them and that there is nothing in the object sought to be obtained and the mischiefs sought to be remedied by the act

> which furnishes foundation for the belief that Congress manifestly intended to place a limitation on the appellate jurisdiction of this court in a case such as this."

In the case last cited a proceeding was brought to cancel a patent on the ground of fraud, but nevertheless this court held that it was not a case "arising under the patent laws," but under the general laws of the United States. Surely if such a case is not a case "arising under the patent laws," an application for relief by way of mandamus to enforce an adjudicated right is also not a case "arising under the patent laws" even if the right to a patent is involved. From the case last above cited, it would appear clear that, the words "arising under the patent laws" were used by Congress to designate the ordinary patent litigations, such as infringement suits, interference proceedings, etc., and were not intended to include proceedings for the cancelation of the patent or any other special proceedings involving patents or patent rights. Attention is directed to the fact that the suits "to obtain patents" referred to in the above case, are suits arising under Section 4915, Rev. Stat. of the U. S., giving an applicant for a patent, whose application has been finally and properly rejected by the Commissioner of Patents or by the court having appellate jurisdiction, the right to proceed by original bill in equity to further test the question of patentability of his invention. Of course, arising under a distinct patent statute the case is a case arising under the patent laws, but no such statute constitutes the foundation for the case at bar.

Attention is also directed to the decision of this

court in *United States ex rel. Miller* v. *Raum,* 135 U. S. 200-204, as follows:

> "And in *United States ex rel. Miller* v. *Black,* 128 U. S. 50, argued at the same time, we held, that when a subordinate officer is overruled by his superior having appellate jurisdiction over him, his duty to obey the decision of such superior is a ministerial duty which he can be compelled by mandamus to perform."

The case last cited was an application for mandamus to enforce a right which had been finally adjudicated in the Pension Office, nevertheless this court decided that mandamus was the proper remedy without mentioning the pension laws. From this it would appear clear that the decision under consideration was not a case arising under the pension laws, and from analogy it would appear to follow that the present case is not a case arising under the patent laws.

As counsel for plaintiff in error understands the position of the government in this matter, it is contended that because the Commissioner asserted that under his supervisory authority he had authority to act as he did, it becomes necessary for this court to construe the statute investing him with such authority, and that therefore this case is one arising under the patent laws. On the contrary it is earnestly contended on behalf of plaintiff in error that all this court has to determine in order to decide this question is whether or not, when a subordinate executive officer of the government is reversed by an appellate tribunal having appellate jurisdiction over him, the carrying into effect of the decision of reversal is a mere ministerial duty which said subordinate may be

compelled by mandamus to perform. Or, in other words, whether or not the decision in *U. S. ex rel. Miller* v. *Raum, supra,* is correct.

The issuing of writs of mandamus has been endorsed by this court in a wide variety of cases involving a wide variety of rights. In *United States ex rel. Miller* v. *Raum,* 135 U. S. 200, the right involved was a pension; in *Butterworth* v. *U. S. ex rel. Hoe,* 112 U. S. 50, the right involved was a patent; in *Ballinger* v. *Frost,* 216 U. S. 240, the right involved was an allotment of lands to Indians; in *Gaines* v. *Rugg,* 148 U. S. 228, the rights involved concerned the title to land and the rents thereof; and *In Re Washington & Georgetown Ry. Co.,* 140 U. S. 91, the rights involved were the result of an action in tort. It thus appears that this court has already endorsed the issuance of writs of mandamus in a wide variety of cases and that it would be willing to endorse the issuance of such a writ to enforce finally adjudicated rights in any case. Surely a right having such wide application could not be said to arise specifically under each one of these separate heads. If the relief sought in the case at bar arises under the patent laws, it necessarily follows that the relief sought in the cases above enumerated arose under the pension laws, under the land laws, under the Indian enactments, under the law relating to torts and each and every specific subject involved in these cases. Looking at the matter in a different light, if the relief sought in the case at bar is a relief *arising under the patent laws,* how is it possible that the same relief is applicable to all these different cases? From these considerations, it is urged that the right to man-

damus does not and cannot arise under the laws of the litigated subject-matter but arises under a law of its own having general application in all finally adjudicated matters. The right to mandamus does not arise until rights have accrued requiring no exercise of discretion but only the application of ministerial duties to perfect, and such rights may obviously arise in any department of our government.

Wherefore your petitioner prays that a rehearing may be granted herein for an early date and that the mandate herein be suspended pending the determination of this petition.

And your petitioner will ever pray.

U. S. *ex rel.* EDWARD L. CHOTT,

Joshua Stoon

....., *Attorney for Plaintiff in Error.*

CERTIFICATE.

I hereby certify that I have examined the foregoing petition and that in my opinion the petition is well founded as to matters of fact and as to matters of law, and that the case identified thereby is one and is such that the prayer of the petitioner should be granted by this Honorable Court.

Joshua Stoon

....., *Attorney for Plaintiff in Error.*

trict of Columbia under § 250 of the Judicial Code, are stated in the opinion.

Mr. Joshua R. H. Potts for plaintiff in error.

Mr. Assistant Attorney General Warren, with whom *Mr. R. F. Whitehead* and *Mr. W. S. Ruckman* were on the brief, for defendant in error.

Mr. Chief Justice White delivered the opinion of the court.

A brief statement of the origin and nature of the controversy is essential to an understanding of the questions which we are called upon to decide. The relator applied for a patent. His claim was rejected by the primary examiner. He appealed to the Board of Examiners in Chief, and that body, disagreeing with the primary examiner, reversed his decision and sustained the claims of the patent. By authority of the Commissioner the primary examiner then made a further investigation and directed the attention of the Commissioner to additional patents which it was deemed demonstrated that the invention was not patentable. Thereupon the Commissioner, coinciding with such opinion, approved the action of the primary examiner and decided that the invention was not patentable. The Commissioner, however, did not then formally reject the claim to patent but wrote to the applicant calling attention to the authority of the Commissioner to review the case personally despite the favorable action of the Board of Examiners in Chief and assigning a day when a hearing would be afforded as to the patentability of the invention. The applicant challenged the right of the Commissioner to act in the premises and insisted that as a result of the conclusions of the Board of Examiners in Chief he was

entitled to a patent and that it was the plain ministerial duty of the Commissioner to direct it to issue. The Commissioner then filed an opinion insisting upon his authority and pointing out the reasons which caused him to conclude that the invention was not patentable. The opinion concluded with the statement, "I am clearly of the opinion that the application sets forth nothing upon which a patent can properly be based. The claims are therefore rejected and the patent refused. Appeal from this decision to the Court of Appeals should be taken, if at all, within the time prescribed by the rules of that court."

Instead of taking the appeal as thus suggested, the relator commenced this proceeding by mandamus in the Supreme Court of the District to compel the issue of the patent. From a judgment in his favor ordering the mandamus as prayed the Commissioner and the primary examiner prosecuted error to the Court of Appeals. That court, concluding that it was without authority to control the Commissioner in the performance of his administrative duties by the writ of mandamus, reversed the action of the trial court, directed the dismissal of the application for mandamus, reserving however the right of the relator to seek by appeal (Rev. Stat. § 4911) the redress of any wrong which it was deemed had been committed by the Commissioner in refusing to direct the issue of the patent, and this writ of error is prosecuted to that judgment. 40 App. D. C. 591.

At the threshold our jurisdiction to review is disputed on the ground that the concluding paragraph of § 250 of the Judicial Code upon which our jurisdiction depends provides that "Except as provided in the next succeeding section, the judgments and decrees of said Court of Appeals [of the District of Columbia] shall be final in all cases arising under the patent laws," and that the exception embraced in the subsequent section includes

only the discretionary right to certiorari and the power of the Court of Appeals to certify a question under the circumstances provided. On the other hand, it is insisted jurisdiction obtains because of the right of this court to review the judgments and decrees of the Court of Appeals of the District conferred by the fifth paragraph of § 250, that is, "in cases in which the validity of any authority exercised under the United States, or the existence or scope of any power or duty of an officer of the United States is drawn in question." Our jurisdiction is therefore to be determined by fixing the meaning of these two provisions. It cannot be doubted that isolatedly considering the text of the fifth paragraph the controversy comes within its terms, that is, it involves the validity of an authority exercised under the United States or draws in question the existence or scope of the power of an officer of the United States. So also it is not substantially disputable, although the contrary is argued, that isolatedly considered the case is excluded from our jurisdiction because it is within the last paragraph of § 250, that is, is one arising under the patent laws since it depends upon those laws and concerns the very right and authority to issue a patent as provided by those laws. Looked at isolatedly, therefore, there is absolute conflict between the two provisions. But even if the method of isolated consideration were not otherwise plainly a mistaken one, it follows that it cannot be adopted since it affords no possible solution of the controversy. Such solution must therefore be sought by following the elementary rules, that is, by turning primarily to the context of the section and secondarily to provisions *in pari materia* as affording an efficient means for discovering the legislative intent in enacting the statute thereby vivifying and enforcing the remedial purposes which it was adopted to accomplish.

From the point of view of the context, as it is manifest

that the provisions in the concluding clause were enacted as exceptions or limitations upon the grant of jurisdiction contained in the previous passage of § 250, it clearly results that it was not contemplated that the power conferred by the fifth paragraph would extend to and embrace the cases wherein by the last paragraph the judgments or decrees of the Court of Appeals of the District of Columbia were made final. This being true, it hence also is necessarily true that the fifth paragraph concerning the validity of an authority confers no jurisdiction on this court to review a case where the question of authority arises under the patent laws of the United States. Indeed it would be very unreasonable to assume that jurisdiction was conferred to review the action of the Court of Appeals in all cases in which its authority was exerted to direct the officials of the Patent Office under the patent laws to issue a patent, and yet no power was reserved to review the action of that court in determining after the issue of a patent whether it was or was not rightfully issued. And the cogency of this view becomes at once apparent when it is considered that prior to the enactment of the Judicial Code, under § 233 of the District Code (31 Stat. 1227) jurisdiction of this court to review the judgments or decrees of the Court of Appeals of the District embraced cases "without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent," a provision not preserved in § 250 of the Judicial Code. But the question is hardly an open one since it has been expressly held that the power does not exist in this court to review the Court of Appeals of the District of Columbia in a criminal case which would obtain under § 250 but for the provision of the last paragraph making final the action of that court in criminal cases. *Gompers* v. *United States*, 233 U. S. 604. And by analogy a like consideration when applied to the sections of the statute concern-

ing the jurisdiction of this court to review the judgments of Circuit Courts of Appeals has led to a like conclusion. *Macfadden* v. *United States*, 213 U. S. 288. Besides, when looked at comprehensively, in view of the fact that the provisions of the Judicial Code were obviously intended not to enlarge the jurisdiction of this court but to relieve it, and considering in this light the omissions and the limitations therein expressed and the power to certiorari stated in § 251, the conclusion is irresistible that the intent and purpose of the act was, while narrowing the imperative jurisdiction, to create an equipoise by extending the voluntary or discretionary exercise of jurisdiction by means of the writ of certiorari,—a purpose which would be wholly frustrated if the contention as to jurisdiction now insisted upon were sustained.

Dismissed for want of jurisdiction.